REMARKS

Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 19, 35, 50, and 51 have been amended. Claims 19-51 are pending in this application.

Objection to the Specification

The Examiner objects to the specification under M.P.E.P. § 608.01 as it contains an embedded hyperlink. *See* Final Action, pg. 2. Please note that the specification has been amended to delete the embedded hyperlink.

Rejection Under 35 U.S.C. § 102(b)

Claims 19-28, 31-43, and 46-51 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,128,625, issued to Yankowski (hereinafter "Yankowski").

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *See* M.P.E.P. § 2131; *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P 2131.

Claims 19 and 35 each recite "extracting a plurality of characteristics from a media sample." In the Final Action the Examiner points to Yankowski, at col. 5 lines 45-65, as satisfying this limitation. *See* Final Action, pg. 2. However, Yankowski merely describes reading Table of Contents (TOC) data from a compact disc (CD). Each TOC entry includes the elapsed time of each tract and an absolute time for the POINT content (which is an absolute time defined by the beginning of tract 1 of the CD). *See* Yankowski at col. 5 lines 49-52. Applicant respectfully points out that a CD is not a media sample, as required by claims 19 and 35. Rather, a CD is a digital medium from which media samples may be read. Moreover, Yankowski does not extract a plurality of characteristics from a media sample.

Instead, Yankowski merely describes reading TOC data, which includes information such as the number of tracts, the lengths of each tract, etc. Clearly, merely reading existing TOC data from a medium is not the same as extracting a plurality of characteristics from a media sample. As such, Yankowski does not teach extracting a plurality of characteristics from a media sample, as set forth in claims 19 and 35. In view of the above, Yankowski fails to teach every limitation of Applicant's claimed invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 50 recites "extracting one or more characteristics from the music sample...." In the Final Action the Examiner points to Yankowski, at col. 5 lines 45-65, as satisfying this limitation. *See* Final Action, pg. 2. Applicant respectfully points out that for the same reasoning set forth above with respect to claims 19 and 35, Yankowski also does not teach this limitation. In view of the above, Yankowski fails to teach every limitation of Applicant's claimed invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claims 19 and 35, as amended, also recite "deriving fingerprint/landmark pairs from said characteristics" and claim 50, as amended, also recites "deriving fingerprint/landmark pairs from said characteristics using an updateable or replaceable algorithm." In the Final Action the Examiner equates "fingerprint/landmark pairs" to "fingerprints and Point value." *See* Final Action, pg. 3. Applicant respectfully points out that Yankowski does not derive any of the information used to identify the CD's. Instead, Yankowski merely reads data (e.g., TOC information) and compares that data to a database in order to identify a compact disc. Part of the TOC information includes the elapsed time of each tract and an absolute time for the POINT content (e.g., the POINT value). *See* Yankowski at col. 5 lines 49-52. The TOC information is simply read from the CD. Also, Applicant points out that the TOC content and POINT value do not constitute fingerprint/landmark pairs, as set forth in the claims. Yankowski uses the word fingerprint to denote a collection of information sufficient to uniquely identify a CD. However, this is not the same as fingerprints as set forth in Applicant's claimed invention. Also, there is no teaching that the information read by Yankowski forms a pair with the POINT value (which the Examiner equates to a landmark). The POINT value merely represents a time period defined by the beginning of tract 1 and an instance in a song, as is a component of the TOC content. Instead, the POINT values are merely a subset of the TOC content data. Yankowski's TOC data may be partially

represented in terms of a POINT value. *See* Yankowski, Fig. 1. Certainly, Yankowksi cannot be said to derive TOC content/POINT values pairs from the CD. In view of the above, Yankowski fails to teach every limitation of Applicant's claimed invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claims 20-28, 31-34 depend from claim 19, claims 36-43, and 46-49 depend from claim 35, and claim 51 depends from claim 50. Each dependent claim inherits every limitation of the claim from which it depends. As shown above, Yankowski fails to teach every limitation of claims 19, 35, and 50. As such, claims 20-28, 31-34, 36-43, and 46-49 are patentable in their own right and at least through their dependent claims 19, 35, and 50. Therefore, Applicant requests withdrawal of the rejection of record.

Rejections Under 35 U.S.C. § 103(a)

Claims 19, 35, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yankowski in view of Applicant's Admitted Prior Art (hereinafter "AAPA") and further in view of U.S. Patent No. 5,829,004, issued to Au (hereinafter "Au").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria are satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the third criteria.

As shown above, Yankowski fails to teach or suggest every limitation of claims 19, 35, and 50. Moreover, neither AAPA or Au is relied upon to teach or suggest the missing limitation. As an initial matter, Applicant cannot discern from the Final Action what the Examiner relies upon Au to teach or suggest. Moreover, Applicant respectfully points out that there is no AAPA. Specifically, the reference cited by the Examiner could only be considered prior art under 35 U.S.C. 102(e), which cannot serve as a basis for a 35 U.S.C. 103 rejection, where there is common ownership. In the case at hand, the Examiner's cited

reference and the pending application are commonly owned by Landmark Digital Services, LLC. In any event, the Examiner's proposed combination fails to teach or suggest every limitation of Applicant invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claims 29, 30, 44, and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yankowski in view of U.S. Patent No. 6,819,721 issued to Kobayashi et al. (hereinafter "Kobayashi").

Claims 29 and 30 depend from claim 19 and claims 44 and 45 depend from claim 35, respectively. Each dependent claim inherits the limitations of the claim from which it depends. As shown above, Yankowski fails to teach or suggest every limitation of claims 19 and 35. Moreover, Kobayashi is not relied upon to teach or suggest the missing limitations. As such, claims 29, 30, 44, and 45 set forth limitations not taught or suggested by the Examiner's proposed combination and are patentable at least through their dependency on claims 19 and 35. Therefore, Applicant requests withdrawal of the rejection of record.

Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 69323/P004US/10511468 from which the undersigned is authorized to draw.

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Respectfully submitted,

By Robert Greeson

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